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PROSKAUER ROSE LLP PATENT DEPARTMENT 1585 BROADWAY NEW YORK, NY 10036-8299			FISCHER, ANDREW J	
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* WALTER D. BUIST

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Appeal 2008-4102  
Application 10/666,817  
Technology Center 3600

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Decided: December 29, 2008

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Before, HUBERT C. LORIN ANTON W. FETTING and JOSEPH A.  
FISCETTI, *Administrative Patent Judges*.

FISCETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-24. We have jurisdiction under 35 U.S.C. § 6(b). (2002).

## SUMMARY OF DECISION

We AFFIRM.

## THE INVENTION

Appellant claims use of a Financial Information Exchange (FIX) Protocol to communicate a coded message having a meaning outside the publicly-known meaning within the protocol. (Specification 2:¶¶0008])

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A method for securely communicating financial information, comprising:

receiving over an electronic computer network a message communicated according to a field delimited communication protocol pursuant to which the message comprises a financial data field and a field value corresponding to the financial data field and the message has a standard, publicly-known meaning within the field delimited communication protocol;

and interpreting said message according to a coded meaning defined to be different than the standard, publicly-known meaning within the field delimited communication protocol.

### THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Hausman                      US 2004/0030632 A1              Feb. 12, 2004

The following rejection is before us for review.

1. The Examiner rejected claims 1-24 under 35 U.S.C. 102(e) as being anticipated by Hausman.

### ISSUE

Has Appellant shown that the Examiner erred in rejecting claims 1-24 on appeal under 35 U.S.C. § 102 (e) as anticipated by Hausman on the grounds that the system in Hausman is capable of allowing a message to have a coded meaning different than the standard, publicly-known meaning within the field delimited communication protocol.

### FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. Claim 1 does not require the use of a device to interpret a FIX formatted message.
2. The Specification describes several examples in ¶¶ [0031-0033] in which interpreting a message according to a coded meaning defined to be different than the standard, publicly-known meaning is accomplished by human intervention. In each example, the Specification states that buyers B/C/D "...would not interpret the message as an order for...." a value according to the FIX meaning, but as an

order for value after translated according to a coded meaning. (Specification 5: ¶¶ [0031-0033].) Thus the persons B/C/D are interpreters.

3. The Examiner found that

... Hausman teaches a method for securely communicating (transmitting) financial information (financial interest), comprising receiving over an electronic computer network (network, 100) a message communicated according to a field delimited communication protocol (FIX) pursuant to which the message comprises a financial data field (financial interest) and a field value (price parameter) corresponding to the financial data field and the message has a standard, publicly-known meaning within the field delimited communication protocol....

(Final Rej. 2, Answer, 3)

4. Hausman discloses the use of field delimited communication protocol having standard, publicly-known meaning such that:

...terms are formatted according to a protocol, as for example the FINANCIAL INFORMATION EXCHANGE PROTOCOL (FIX) described in a document entitled FINANCIAL INFORMATION EXCHANGE PROTOCOL (FIX), Version 4.2 with Errata 20010501, published May 1, 2001, by FIX Protocol Limited; or the TICKET ORDER FEED PROTOCOL. (Hausman, [0041])

5. It is our understanding that a human mind is capable of following a mental algorithm, such as multiply all order values by 10.

6. Hausman discloses

The user can then designate the nature of the operand to be used in determining the price term for his

trading proposal by entering data in either one of fields 352, 353. By entering a price step in field 352, the trader can designate that he/she wishes the price term for his proposal to be set at a constant stated offset from the reference yen price, so that as the reference yen price rises and/or falls, the price term for the trader's proposal rises and/or falls at a constant offset. By entering a ratio in field 353, the trader can designate that the price term for the proposal will float with the reference yen price by the stated ratio. For example, were a trader to enter "30" in field 352, the price term for his proposal would float at a constant "30" dollar level above the reference yen price. Were the trader to enter "1.50" in field 353, the price term would float at a constant 150% of the reference yen price. (Hausman, [¶0075])

7. Hausman discloses the situation where an order entered in one currency trades in a different currency. (Hausman, [¶0058])

## PRINCIPLES OF LAW

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language,

but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

“It is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it. Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates.” *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002) (citations and internal quotation marks omitted).

The Board may find in the prior art a feature which is capable of performing a function recited in the claims. “The Board’s finding that the scaled-up version of figure 5 of Harz would be capable of performing all of the functions recited in Schreiber’s claim 1 is a factual finding, which ...[otherwise] ...must be shown to be clearly erroneous...” *In re Schreiber*, 128 F.3d 1473, 1479 (Fed. Cir. 1997).

## ANALYSIS

### *Claims 1-21*

Appellant argues claims 1-21 as a group<sup>1</sup>. We select claim 1 as the representative claim for this group, and the remaining claims 2-21 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

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<sup>1</sup> A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. See, 37 C.F.R. § 41.37

It is undisputed that Hausman discloses all the limitations of claim 1 up to the interpreting step. (Appeal Br. 13.) What is disputed by Appellant is whether Hausman teaches, discloses, or suggests interpreting the FIX formatted "...message according to a coded meaning defined to be different than the standard, publicly-known meaning within the field delimited communication protocol..." (Appeal Br. 13.)

Appellant argues that the Examiner is espousing that limitations in the claims "...should be ignored and read out of the claims because the step of interpreting a message according to a coded meaning is purportedly performed by a human, and patentability cannot be predicated by a "mental step." (Reply Br. 3, 4.) We agree with Appellant that the step of interpreting a message according to a coded meaning cannot be ignored in claim 1. Rather, in construing claim language, we consider all words of a claim in judging patentability of the claim against the prior art, but do so with an eye as to whether the prior art is capable of performing a function recited in the claims. *See, In re Schreiber*, at 1479.

Preliminarily, we find that claim 1 does not require a machine to interpret the FIX formatted messages (FF 1). Appellant also admits that "[c]laim 1 does not require the interpretation step to be performed by a computer." (Reply Br. 6.) Thus, the recited interpreting step of the method claims can be accomplished by human analysis to meet the claim limitation. Since the system in Hausman communicates to a recipient values such as "30" for the price term in field 352 in a



proposal, the recipient is fully capable of interpreting this value as thirty-its standard, publicly-known meaning. Alternatively, the recipient may interpret the value to mean three hundred “30”x10- differently from a publicly-known meaning, depending on the understanding the recipient has with the trader (FF 5). Hausman in particular describes the situation where an order in one currency trades in a different currency, in which case data entered would nominally have a standard meaning of one currency but would be interpreted for trading as the other currency (FF 7). Accordingly, we are not persuaded of error in the rejection.

*Claims 22 and 23*

Appellant argues that claims 22 and 23 require a device to conduct the recited interpreting and encoding functions, and thus cannot be anticipated by a mental step of a human. (Reply Br. 4, 5.) We agree with Appellant that claims 22 and 23 are apparatus claims and the prior art must show a device performing or capable of performing the recited function in order to meet the claim limitations. *See, In re Schreiber*, 128 F.3d 1473, 1477-78 (Fed. Cir. 1997). Claim 22 recites an interpreter for interpreting a message so as to have a meaning different from a standard, publicly known meaning, and claim 23 recites an encoder for encoding a message field (Reply Br. 4, 5). We find that Hausman discloses an interpreter in the form of a currency translator device which interprets the desired value of money an orderer wishes to spend in one currency and translates that value into another country’s currency (FF 6). The currency translator device in Hausman also includes an encoder which encodes a value entered as either a percentage or float to translate the same value into foreign currency (FF 6).

Appellant next argues that the claimed translator/encoder devices are further required by the claims to interpret/encode messages intended to have a meaning different from the standard, publicly-known meaning. (Reply Br. 5, 6.) We disagree with Appellant. Appellant uses functional language in each of claims 22 and 23 to describe the respective functions of the interpreter and the encoder. As functional language, we are required to give this language weight to the extent that the prior art is or is not capable of meeting the limitation. *See, In re Schreiber* at 1477-78. (Fed. Cir. 1997). The currency translator apparatus in Hausman performs automatic calculations (FF 6) and is thus capable of being programmed to encode and interpret the values which it messages, e.g., multiply every value entered by 10 (encode) and divide the received value by 10 (interpret). We therefore are not persuaded as to error in the rejection of claims 22 and 23.

### CONCLUSIONS OF LAW

We conclude the Appellant has not shown that the Examiner erred in rejecting claims 1-24 under 35 U.S.C. § 102(3) as anticipated by Hausman.

### DECISION

The decision of the Examiner to reject claims 1-24 is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

Appeal 2008-4102  
Application 10/666,817

AFFIRMED

LV:

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